

that claim 1 does not describe a species different from that recited in claims 4-7, but is generic relative to the alleged species described in claims 4-7. *See* Manual of Patent Examining Procedure (MPEP) 806.04(d), at (“In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.”). Consequently, the comment that claims 4-7 and claim 1 (and, given that the only distinction that is drawn is made relative to the language of claim 1, claims 2, 3, and 8-18 that depend from claim 1) describe different species should be withdrawn.

Moreover, to the extent that the alleged distinction between claim 1 and claims 19-21 (claim 19 independent and claims 20 and 21 depending from claim 19) is the generation of a transparent overlay indicative of a three-dimensional game option, claim 1 is generic to this subject matter, as shown relative to claims 4-7 above. Therefore, the comment that claims 19-21 and claim 1 (and, again, claims 2, 3, and 8-18) describe different species should also be withdrawn.

Lastly, the MPEP 803 states (at 800-4): “If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions” (emphasis added). Here, the examiner has already searched both of the alleged species, and indicated that she considered the subject matter claimed by applicant in claims 1-18 and 19 (previously presented by way of claim 23) to be allowable over the art of record. Thus, the search and the examination of the entire application present no serious burden. For this reason as well, the applicant submits that the restriction is improper.

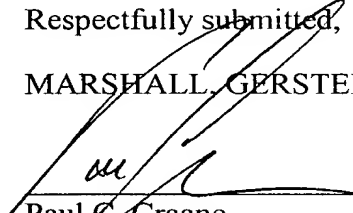
Reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

MARSHALL GERSTEIN & BORUN

Date: January 20, 2004

By:


Paul C. Craane

Registration No. 38,851
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300



Creation date: 09-10-2004
Indexing Officer: ABEJENUTA - ALIONA BEJENUTA
Team: OIPEBackFileIndexing
Dossier: 09966851

Legal Date: 03-30-2004

No.	Doccode	Number of pages
1	CTNF	9
2	892	1

Total number of pages: 10

Remarks:

Order of re-scan issued on